



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: GOERING, Thomas

Appl'n No.: 10/665,305

Filing Date: 22 September 2003

For: SYSTEM AND METHOD FOR REUSING FORM
ELEMENTS IN A FORM BUILDING APPLICATION

Group Art Unit: 2176

Examiner: Singh, Rachna

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Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejections in the Office action mailed August 14, 2006 ("Final Rejection") in connection with the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

The review is requested for at least the following reasons:

ARGUMENTS

Claims 1-18 are pending in the application. Claims 1, 9 and 17 are the independent claims. (Previously pending claim 19 was canceled in Applicant's October 26, 2006 After-Final Amendment). The pending independent claims follow:

1. **(Original)** A computer system for generating output modules in a form-based application runtime environment, comprising:
 - a form manager component configured to receive an indication that a reusable form element has been changed, determine which output modules from a set of output modules are affected by the changed form element, and invalidate the affected output modules; and
 - a runtime manager component configured to receive a request for an output module from the set of output modules and cause regeneration of the requested output module if the requested output module has been invalidated.

9. **(Original)** A computer-implemented method for generating output modules in a form-based application runtime environment, comprising:
 - receiving an indication that a reusable form element has been changed;
 - determining which output modules from a set of output modules are affected by the changed form element;
 - invalidating the affected output modules;
 - receiving a request for an output module from the set of output modules; and
 - regenerating the requested output module if the requested output module has been invalidated.

17. (Original) A computer-implemented dynamic form building method, comprising:
- responsive to a call to start a form output process based on an identified form:
 - determining whether a previously generated output module associated with the identified form in an output module library has been marked as invalid;
 - if so:
 - regenerating the output module; and
 - storing the regenerated output module in the output module library along with a marker to indicate that the output module is valid.

Hitchcock Clearly Fails To Teach or Suggest Invalidating and Regenerating Output Modules

Independent claim 9 recites, in part, “invalidating . . . output modules” and “regenerating [a] requested output module if the requested output module has been invalidated”. Independent claim 1 includes similar recitations. Independent claim 17 recites, in part, “determining whether a[n] output module . . . has been marked as invalid” and “if so: regenerating the output module”.

It is clear from the specification and plain meaning that an “output module” is a module that provides output, and is not the output itself. In the context of forms, a form output module processes form data for presentation (e.g., via printer, web browser, etc.). See specification, p. 2, lns 14-16. Thus, form data and form output are entities clearly distinct and separate from a form output module.

The Office rejected the pending claims 35 U.S.C. § 103(a) as being unpatentable over Hitchcock (U.S. Patent Application Publication No. 2005/0080756 A1). However, no aspect of Hitchcock, taken alone or in combination, teaches or suggests invalidation of output modules as claimed.

In fact, Hitchcock explicitly teaches *against* invalidating output modules by stating that “[t]he applicant database can be extended to include new attributes *without making any changes to the forms engine program*”. Hitchcock, para. 0065, lns 1-3 (emphasis added). The essence of

Hitchcock is to provide a universal forms engine or output module that is extensible *without programming* (see Hitchcock, Abstract).

The Office bases all of its rejections on the incorrect notion that the claimed output module can be equated with a form in Hitchcock. See Final Rejection, p. 4, ln 17 – p. 6, ln 7. The Office essentially contends that allowing a user to change the data to be displayed in a form is equivalent to invalidating and regenerating an output module.

As described above, form data and form output are entities *clearly and factually distinct and separate from* a form output module. Thus, the Office's position lacks any factual basis and demonstrates clear error, and therefore should cause the Final Rejection to be withdrawn.

CONCLUSION


It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

Dated: November 14, 2006


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